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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/395,805

09/14/1999

HIDEYUKI KINOSHITA

PM-264009

6497

22242

7590

12/17/2003

FITCH EVEN TABIN AND FLANNERY  
120 SOUTH LA SALLE STREET  
SUITE 1600  
CHICAGO, IL 60603-3406

EXAMINER

SHEWAREGED, BETELHEM

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 12/17/2003

34

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/395,805

Applicant(s)

KINOSHITA ET AL.

Examiner

Betelhem Shewareged

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 11 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

1. Applicant's response filed on 03/06/2003, 06/24/2003 and 09/22/2003 have been fully considered. Currently, claims 1-12 are pending. (NOTE: Claims 11 and 12 are withdrawn from consideration as non-elected claims).

### *Election/Restrictions*

2. Applicant's election with traverse of Species A claims 1 and 4-10 in Paper No. 33 is acknowledged. The traversal is on the ground(s) that claim 11 does not explicitly recite a third layer or a layer of release agent. This is not found persuasive because claim 11 recites, "a release agent is provided **on a surface** the thermoplastic film which is not laminated to said substrate". Since the claim does not expressly recite that the release agent is impregnated into the thermoplastic film which is not laminated to said substrate, the release agent is formed on the surface of the thermoplastic film, thus the release agent that is formed on the surface of the thermoplastic film is interpreted as a layer of release agent.

Furthermore, claim 12 is directed to method of stencil printing, wherein such printing is examined in class 101. The examiner previously showed that the reason for restriction, that is the process for using the product as claimed can be practiced with another materially different product, (e.g., providing a heat sensitive stencil fabric comprising hydrophilic vinyl monomers graft-polymerized with cellulose fibers; feeding the heat sensitive stencil to a stencil printing apparatus; and conducting stencil printing with the stencil printing apparatus). The heat sensitive stencil in the above example is

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different from the claimed heat sensitive stencil. The following is an additional reason for restriction requirement: The product as claimed can be used in a materially different process of using that product, (e.g., the product can be used as a wall paper or a gift wrap).

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 102***

3. Claims 1 and 4-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Kawatsu et al. (US 6,025,286).

A heat-sensitive stencil sheet comprises a fibrous support of polyester fibers, and a polyester film laminated on the fibrous support. Adhesive may be used for laminating the fibrous support and the polyester film (abstract, background art and claim 1). The fibrous support of polyester fibers is equivalent to the claimed fiber-containing porous substrate, and the polyester film is equivalent to the claimed thermoplastic resin film. With respect to tensile strength value, T-H value, and KES bending rigidity value B it is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. *In re swinehart et al.*, 169 USPQ 226 at 229. Since the Kawatsu reference teaches all of Applicant's claimed compositional and positional limitations, it is inherent that the reference article function in the same manner claimed by Applicant. The burden is upon Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

***Response to Arguments***

4. Applicant's argument is based on that the Kawatsu article does not inherently possess the claimed properties. The Applicant further provided a Declaration executed by Nakao to show that the Kawatsu article does not inherently possess the claimed properties. This argument is not persuasive because in the Nakao Declaration the Applicant showed that Sample Nos. 7, 8 and 9 of the reference possess residual torque, KES bending rigidity value B, and lengthwise tensile strength within the claimed ranges.

In addition, the Examiner agrees with the Applicant that not all materials made of the same thing have the same properties, i.e., not all stencil sheets have the same properties. However, the Applicant provided a factual evidence that the Kawatsu stencil sheet has a residual torque, a KES bending rigidity value B, and a lengthwise tensile strength within the claimed ranges (See Sample Nos. 7-9 in the Nakao Declaration). Therefore, claims 1 and 4-10 stand rejected.

***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 703-305-0389. The examiner can normally be reached on Mon.-Thur. 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on 703-308-0449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

A handwritten signature in black ink, appearing to read 'B. Shewareged', with a stylized flourish at the end.

Betelhem Shewareged  
December 13, 2003.